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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,811	07/08/2002	Helmut Koelle	34420.00.0003	5239

7590 07/29/2004

Vedder Price Kaufman & Kammholz  
Suite 2600  
222 N LaSalle Street  
Chicago, IL 60601

EXAMINER

JOERGER, KAITLIN S

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,811

Applicant(s)

KOELLE, HELMUT

Examiner

Kaitlin S Joerger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 1,5-7 and 16 is/are rejected.
- 7) ☒ Claim(s) 2-4,8-15,19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 6, 7, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auf der Mauer.

Auf der Mauer teaches a device for transferring at least two sheets, which are arranged in a shingled mode of arrangement in a sheet transport direction, to a sheet handling machine which comprises a first transport unit, 14, which moves the at least two sheets at a first transport speed after the transfer. The two sheets are spaced apart by a certain length of displacement, meaning that they are shingled. The device comprises a feed belt, 28, which performs the same function as a feed roll, and feeds at least two sheets in a shingled mode of arrangement to the sheet handling machine at a second speed, which is higher than the first speed; and a brake roll, 52', which decelerates the second sheet to a third speed as soon as the first sheet is decelerated by the transport unit, the third speed being lower than the second speed, thereby maintaining the shingled mode of arrangement. He further teaches that the brake roll, 52', serves to decrease the speed of the sheet so that the third speed is equal to the first speed, see figure 4-11 and column 8, line 10+ and column 12, lines 55+.

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While Auf der Mauer does not specifically disclose a method, it would have been obvious to perform the method steps of claim 1, 5, and 6 when using the apparatus taught by Auf der Mauer, and as described above, in its usual and expected fashion.

Regarding claim 5, Auf der Mauer discloses the claimed invention except for the optimum speeds specified for the first, second, and third, speeds. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine the optimum operating speed of the sheet-handling machine transport belts, since it has been held that discovering an optimum value of a result effective variable involved only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

#### ***Allowable Subject Matter***

Claims 17 and 18 are allowed.

Claims 2-4, 8-15, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments filed 30 June 2004 have been fully considered but they are not persuasive.

Applicant states that Auf der Mauer does not teach the claimed invention, because he does not teach that the deceleration of the first and second sheets occurs substantially simultaneously. The examiner disagrees with the applicant's argument. The deceleration of the

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first and second sheets of Auf der Mauer obviously occur substantially simultaneously because there is no change in the amount of shingling of the first and second sheets. If the deceleration did not occur substantially simultaneously the first and second sheets would no longer be shingled and it is clear from figures 4-7 that the sheets do remain shingled.

In addition, it is not clear for claim 7 that the applicant is claiming three sheet engagement means. The applicant claims a device, which comprises a transport unit. The applicant then claims that the device comprises a feed roll and a brake roll. As the claim is now written it appears as if the feed roll and brake roll make up the transport unit, and therefore there are only two sheet engagement means, which is taught by Auf der Mauer.

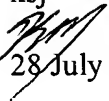
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S Joerger whose telephone number is 703-305-8503. The examiner can normally be reached on Monday - Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksj

  
28 July 20004

  
DONALD F. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600